

REMARKS

This Amendment is filed in response to the Final Office Action mailed January 27, 2009 ("Final Office Action"). In this Amendment, claims 10, 11, 37 and 38 are amended, and claims 12 and 40 are canceled. Claims 13-18, 39, and 41 are unchanged. Claims 1-9, 19-36, and 42-48 were previously withdrawn. Following entry of this amendment, claims 10, 11, 13-18, 37-39, and 41 shall be pending.

In the Final Office Action, claims 10-18 and 37-41 have been rejected based on prior art grounds. For the reasons set forth below, these rejections are hereby traversed.

I. AMENDMENTS TO THE SPECIFICATION

Several paragraphs of the specification have been amended to correct various clerical errors. These errors were first identified during preparation of this Amendment and do not introduce new matter.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 10-18 and 37-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 01/26585 to Altman ("Altman") in view of U.S. Publication No. 2003/0069606 to Girouard et al. ("Girouard et al."). Of these claims, claims 10 and 37 are independent claims. Claims 11-18 are dependent claims that depend from claim 10 or a dependent claim that depends from claim 10, and claims 38-41 are dependent claims that depend from claim 37. For at least the reasons set forth below, it is submitted that these prior art rejections should be withdrawn and the pending claims allowed.

Turning first to independent claim 10, in order to advance prosecution and without conceding to the merits of the rejections, claim 10 has been amended to recite a method of treating an atrial arrhythmia comprising: delivering an unexpanded implant to a target site in an ostial region of a pulmonary vein; expanding said implant to an initial retention state wherein said implant substantially conforms to a wall in said ostial region

of said pulmonary vein; and, allowing said implant to continue to expand over time such that said implant migrates substantially through said wall of said pulmonary vein, said migration causing a circumferential scar tissue response of said pulmonary vein that treats said atrial arrhythmia. Support for these amendments can be found throughout the present application and, more particularly, at paragraphs [0072] and [0073]. No new matter is added through these amendments.

Altman and *Girouard et al.* cannot be properly relied upon at least for the reason that *Altman* and *Girouard et al.* alone or in combination, neither teach nor make obvious allowing said implant to continue to expand over time such that said implant migrates substantially through said wall of said pulmonary vein causing circumferential scar tissue, as recited in claim 10. With respect to *Altman*, as described in the previous response, *Altman* actually teaches away from the present invention. At page 8, lines 6-11, *Altman* teaches that "placement of the stent alone can act to isolate the target pulmonary vein from the atrial conduction and excitation process. The primary advantage of this method is **that no tissue is damaged.**" (Emphasis added). One of ordinary skill in the art would recognize that a method in which no tissue damage is caused, such as *Altman*'s, teaches away from the present invention in which an implant migrates substantially through said wall of said pulmonary vein causing circumferential scar tissue.

With respect to *Girouard et al.*, *Girouard et al.* merely teach that the presence of the stent 110 may cause the desired tissue response. At ¶ [0014], *Girouard et al.* is primarily directed towards causing tissue responses through coating the stent with bioincompatible materials and applying energy to the stent. At ¶¶ [0014] and [0015], *Girouard et al.* neither teach nor suggest an implant that migrates substantially through the wall of the pulmonary vein thereby causing circumferential scar tissue.

In view of the above, it becomes evident that *Altman* and *Girouard et al.* fail to render the present invention as claimed in claim 10 unpatentable. Accordingly, the Applicants respectfully request withdrawal of the present rejections and an indication of allowance.

With respect to claims 11 and 13-18, these claims depend from claim 10 and thus for at least the above reasons are also novel and unobvious over the cited prior art. However, these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

With respect to claim 12, through the present Amendment, this claim has been canceled. Subject matter substantially similar to the subject matter of claim 12 is now recited in amended claim 10.

Turning next to independent claim 37, in order to advance prosecution and without conceding to the merits of the rejections, claim 37 has been amended to recite a method of creating an electrical conduction block in a pulmonary vein ostial region comprising: directing an implant towards said ostial region in said pulmonary vein; retaining said implant in said pulmonary vein with a first component of said implant; causing the formation of circumferential scar tissue in said ostial region of said pulmonary vein by allowing a second component of said implant to migrate into said ostial region at a faster rate than said first component. Support for these amendments can be found throughout the present application and, more particularly, at paragraphs [0143]-[0145]. No new matter is added through these amendments.

Altman and *Girouard et al.* cannot be properly relied upon for rendering the present invention unpatentable at least for the reason that *Altman* and *Girouard et al.* alone or in combination, neither teach nor make obvious causing the formation of circumferential scar tissue in said ostial region of said pulmonary vein by allowing a second component of said implant to migrate into said ostial region at a faster rate than said first component, as recited in claim 37. With respect to *Altman*, *Altman* teaches a stent and method of use that causes no tissue damage. At page 8, lines 6-11. One of ordinary skill in the art would recognize that a method, such as *Altman*'s, in which no tissue damage is caused teaches away from the method allowing a second component of the implant to migrate into the ostial region at a faster rate than said first component, as presently claimed.

With respect to *Girouard et al.*, as described above, *Girouard et al.* merely teaches that the presence of the stent 110 may cause the desired tissue response. At ¶ [0014]. *Girouard et al.* is primarily directed towards causing tissue responses through coating the stent with bioincompatible materials and applying energy to the stent. At ¶ [0014] and [0015]. *Girouard et al.* neither teach nor suggest allowing a second component of an implant to migrate into the ostial region at a faster rate than a first component of the implant.

As evident from the above, *Altman* and *Girouard et al.* fail to render the present invention as claimed in claim 37 unpatentable. Hence, the Applicants respectfully request withdrawal of the present rejections and an indication of allowance.

With respect to claims 38, 39, and 41, these claims depend from claim 37 and thus for at least the above reasons are also novel and unobvious over the cited prior art. However, these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

With respect to claim 40, through the present Amendment, this claim has been canceled. Subject matter substantially similar to the subject matter of claim 40 is now recited in amended claim 37.

Applicant: William Swanson et al.
Serial No.: 10/792,110
Art Unit: 3731

PATENT
Atty Docket: 21947-305

CONCLUSION

In view of the foregoing, it is submitted that pending claims 10, 11, 13-18, 37-39, and 41 are now in condition for allowance. Hence, an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any additional fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,



Shane S. Swanson
Registration No. 52,263

Dated: May 22, 2009

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
Inskeep Intellectual Property Group, Inc.
2281 W. 190th Street, Suite 200
Torrance, CA 90504
Phone: 310-755-7800
Fax: 310-327-3466

Customer No. 37,374